

No. 4105

IN THE

United States Circuit Court of Appeals ³

For the Ninth Circuit

ELOESSER-HEYNEMANN COMPANY

(a corporation),

Appellant,

VS.

KUH BROTHERS (a corporation),

Appellee.

BRIEF FOR APPELLEE.

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FILED

MAR 7 - 1924

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This is an appeal from a final decree made and entered on April 23, 1923, by the District Court of the United States for the Northern District of California, dismissing plaintiff's bill of complaint.

For convenience the appellant will be referred to as the plaintiff and the appellee as the defendant.

Subject Matter.

The suit was brought for the infringement of United States Letters Patent, No. 56,450, issued to Julius Miller and David Macowsky on October 26, 1920, and entitled "Design for Child's Romper", and subsequently assigned to the plaintiff. The

design patent sued on contains no written description, but the drawing shows the front and rear view of a child's romper having (1) a square Dutch neck, (2) short sleeves, (3) simulation of a belt, (4) long legged trousers, (5) peg tops on trousers, (6) patch pockets, and (7) high waist. Defendant at first manufactured a garment similar to plaintiff's but on notice changed to that shown in plaintiff's Exhibit No. 5. This latter garment embraces (1) a round neck, (2) short sleeves, (3) loosely detachable belt, (4) long legged trousers, (5) peg tops on trousers, (6) concealed pockets, (7) yoke, (8) cuffs, and (9) piping at yoke and cuffs.

The defenses relied on are I, Want of Invention by the Patentees and II, Non-infringement by the Defendant.

I.

THE PATENT IN SUIT IS INVALID FOR THE REASON THAT IT DISCLOSES NO INVENTION OVER THE PRIOR ART.

Design patents are granted under Section 4929 of the Revised Statutes of the United States, which provides in part as follows:

“Any person who has invented any new, original, and ornamental design for any article of manufacture not known or used by others in this country before his invention thereof * * * may * * * obtain a patent therefor.”

The same rule as to invention, which applies to mechanical patents, applies with like force and effect to design patents.

In the leading case of *Smith v. Whitman Saddle Company*, 148 U.S. 674, the Supreme Court adopted the rule of law laid down in the earlier case of *Northrup v. Adams*, and held that the law applicable to a design patent

“does not materially differ from that in cases of mechanical patents and ‘all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries * * * shall apply to patents for designs’ (Sec. 4933).” * * * “To entitle a party to the benefit of the act, in either case, there must be originality, and the exercise of the inventive faculty. In the one, there must be novelty and utility; in the other, originality and beauty. Mere mechanical skill is insufficient. There must be *something akin to genius*—an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful or beautiful they may be in their new role is not invention.” “Many illustrations are referred to, as, for instance, the use of a model of the Centennial Building for paper weights and ink stands; the thrusting of a gas-pipe through the leg and arm of a statue of a shepherd boy, for the purpose of a drop light; the painting upon a familiar vase of a copy of Stewart’s portrait of Washington—none of which were patentable, because the elements of the combination were old. The shape produced must be the result of industry, effort, genius or expense, and new and original as applied to articles of manufacture.” (*Italics ours.*)

In the case of *Rose Mfg. Co. v. Whitehouse Mfg. Co.*, 201 Fed. 926, later affirmed by the Circuit Court of Appeals in 208 Fed. 564, the court held,

“The statute (Rev. St. §4929 (U.S. Comp. St. 1901, p. 3398), as amended by Act May 9, 1902, c. 783, 32 Stat. 193 (U. S. Comp. St. Supp. 1911 p. 1457)) authorizes the issue of such a patent under certain conditions to ‘any person who has invented any new, original and ornamental design for an article of manufacture’. Hence, it appears that a valid design patent demands, as has uniformly been held, an exercise of the inventive faculty the same as a mechanical patent. The design, however, thus invented must be not only new and original, but ornamental. It must exhibit something which appeals to the aesthetic faculty of the observer. *Rowe v. Blodgett & Clapp Co.* 112 Fed. 61, 50 C.C.A. 120; *Williams Calk Co. v. Kemmerer*, 145 Fed. 928, 76 C.C.A. 466.”

This was also held in the case of *Charles Boldt Co. v. Turner Bros. Co.*, 199 Fed. 139, where the court says:

“It is, of course, extremely difficult to clearly mark the line at which symmetry and attractiveness cease to be mere matters of good taste and become touched with a spark of inventive genius. Indeed, a glance at the decisions which have sustained design patents seems to suggest that there may be often more inventive genius displayed by the court in finding invention in design patents than the inventor disclosed in placing it there. However the statute means something, and when this is comprehended it is the duty of the courts to give it effect. * * *

“Neither that decision” (*Smith v. Whitman Saddle Co.*) “nor the statute have, however,

been modified as to the significance of the term 'invention', used in both, and it may be assumed that, notwithstanding the construction which appellant claims the courts have later placed upon them, that term has not become meaningless, and must yet be deemed the main feature to be taken into consideration in determining the validity of a design patent."

To the same effect it was held in the case of *Steffens v. Steiner*, 232 Fed. 862,

"The question in the case at bar is not whether a design patent can be sustained, although each separate element in the design may be old, but it is whether what has been done in assembling the old elements in the new designs rose in these particular cases to the level of invention. * * *

To sustain a design patent the design must involve something more than mere mechanical skill. There must be invention."

Likewise in the case of *Strause Gas Iron Co. v. William Crane Co.*, 235 Fed. 126, where the design for a sad iron was involved, the court held that

"the test for invention is to be considered the same for designs as for mechanical patents; i.e., was the new combination within the range of the ordinary routine designer? We believe that any one starting to design sad irons with the art before him, and governed only by considerations of proportion and plan, would have had no difficulty in making the plaintiff's iron."

And later, in the case of *Smith v. Peck, Stow & Wilcox Co.* 262 Fed. 415, the Court of Appeals held

"To successfully establish the validity of the design patent, and to entitle the inventor to

protection, he must establish a result obtained, which indicates, not only that the design is new, but that it is beautiful and attractive. It must involve something more than mere mechanical skill. There must be invention of design."

That the exercise of the inventive faculty applies to design patents as well as mechanical patents, is clearly recognized by this court, as will be seen from the case of *Hammond v. Stockton Combined, etc., Works*, 70 Fed. 716, where a design patent for a form of open compartment street car, which may still be seen in San Francisco was involved. The court speaking through Judge Ross held in part as follows:

"To entitle a party to a patent for a design under this Act there must be originality, and the exercise of the inventive faculty. This is so, because the statute so declares, and because it has been so decided by the Supreme Court. *Smith v. Saddle Co.* 148 U.S. 674-679, 13 Sup. Ct. 768".

Later, in the case of *Myers v. Sternheim*, 97 Fed. 625, Judge Ross again delivering the opinion of the court says that

"The exercise of the inventive faculty is just as essential to the validity of a design patent as it is to the validity of a patent for any kind of a mechanical device. *Smith v. Saddle Co.*, 148 U.S. 674; *Hammond v. Agricultural Works*, 70 Fed. 716."

In the case of *Faris v. Patsy Frok and Romper Co.* 273 Fed. 900, Judge Morrow, rendering the

opinion of this court said in reference to the Design Patent Statute, in part as follows:

“We understand now the scope and purpose of the present statute. It is limited to the promotion of the decorative arts. In the production of a design within its scope ‘there must be originality and the exercise of the inventive faculty. * * * There must be originality and beauty. Mere mechanical skill is not sufficient’. And these elements must be found in an invention of a ‘new, original, and ornamental design for an article of manufacture.’”

And this court in the case of *Majestic Electric Development Co. v. Westinghouse Electric and Manufacturing Co.*, 276 Fed. 676, speaking through Judge Wolverton, said:

“It requires the exercise of inventive faculty equally in a design as in a utility patent to insure validity, and the test of invention is the same”. (Citing cases.)

In *Macomber on Patents* it is said at page 23 on the subject of Design Patents:

“Between the opinion in *Gorham v. White*, 81 U.S. 511, and that in *Smith v. Whitman*, 148 U.S. 674,—the latter modifying the former—we may approach the essential characteristics of a patentable design. It is clear that the foundation of a patentable design must be something more than mere mechanical skill, something more than artistic arrangement. It must be a distinct product of the brain, as much as the invention of a machine, though not from the same corner of the brain. It has been said that the test of infringement is whether the design in question would, to the eye of the ordinary observer, appear to be the same as the

design of the patent. Such a rule is proper in the case of a trade mark; but it is referred to here as showing how the courts have, at times, wholly missed the mark in the consideration of the essentials of a true design. A true design appeals to something more than the eye in the ordinary sense of that term. It appeals through the eye to the artistic consciousness—not by any particular feature, contour or configuration, or even a collocation of elements, as in the case of a trade-mark—and awakens a response in the mind of the person possessed of a sense of art. If it falls short of this, if to the person with this sense it is merely peculiar or ornamental, it is not the creation by one mind of that which awakens a response in the mind of another, which constitutes true design invention. It follows, necessarily, that so-called ‘mechanical’ designs are not patentable, and that one may not reinforce a mere trade-mark by patenting it as a design.”

Judge Bourquin, holding court in the Northern District of California, before whom the present case was tried, likewise followed this rule, and referring to the plaintiff’s patent and the defendant’s play suit, held that

“In both, however, there is none of the patentee’s genius of invention or artistry, but only the trade instinct of the manufacturer and salesman.”

In view of the foregoing rule of law, applied by Judge Bourquin in this case, we think it must be held that the patent in suit is void for want of invention. It merely displays the ordinary skill of the routine designer, the manufacturer, or the salesman. It does not rise to the dignity of invention.

It does not disclose anything "akin to genius". It is invalid for want of invention.

Applying the rule of law to the facts in this case.

Louis Kuh, together with his brother, Irwin Kuh, have been in business in San Francisco about twenty-five years. The firm is known as Kuh Brothers, Incorporated, defendant in this suit. They were the first manufacturers of play suits on the Pacific Coast.

Called as witness on behalf of defendant, Louis Kuh testified that his firm had made all kinds of children's play suits, rompers, and creepers. That in designing the defendant's garment, alleged to be an infringement, he merely took two old garments to wit, the pink romper or creeper, marked Defendant's Exhibit M, and the old blue and white play suit, Marked Defendant's Exhibit O, and combined them together into one garment, (Record p. 109.) In other words, he cut off the bottom of Exhibit M and the top of Exhibit O and this resulted in joining the top of Exhibit M with the bottom of Exhibit O, thus forming a new garment which is now alleged to be an infringement. This is in evidence as Plaintiff's Exhibit 5.

A casual examination of Exhibit M shows that the pink romper contains (1) a square Dutch neck, (2) short sleeves, (3) yoke; and an examination of Exhibit O shows that it contains (4) long legs, (5) peg tops on trousers, (6) side pockets, and (7)

waist line in simulation of a belt. A drawing showing the upper portion of Exhibit M and the lower portion of Exhibit O, appears on the opposite page.

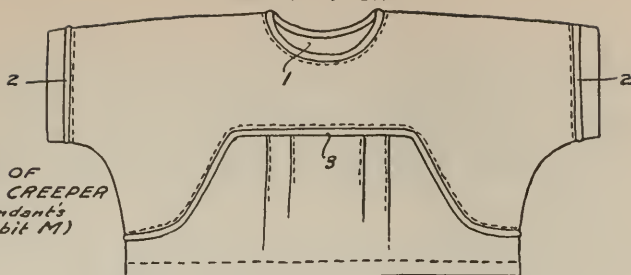
Miss Henrietta Loeb collaborated with Mr. Kuh, and by mechanical skill in using portions of these two previously manufactured garments they designed the garment now alleged to infringe. Here then is a perfect illustration of mechanical skill as distinguished from invention. Miss Loeb, whose testimony commences at page 119 of the record, fully corroborates Mr. Kuh. The garment, Exhibit M, was on the market some ten or fifteen years ago (Record p. 86), and that in evidence as Exhibit O, known as the blue and white play suit, about six or seven years before the trial of this suit. (Record p. 102.)

Other exhibits in this case are further proof that it required no invention to produce the design of plaintiff's patent. Defendant's Exhibit E, a book entitled "Dutch Twins", shows substantially every element of plaintiff's design. It shows a square Dutch neck, short arm, high waist with buttons, peg-shaped trousers, long legs and side pockets. Compare this with the plaintiff's patent, side by side, and how is it possible to conclude that the patentee displayed "something akin to genius" in producing plaintiff's design?

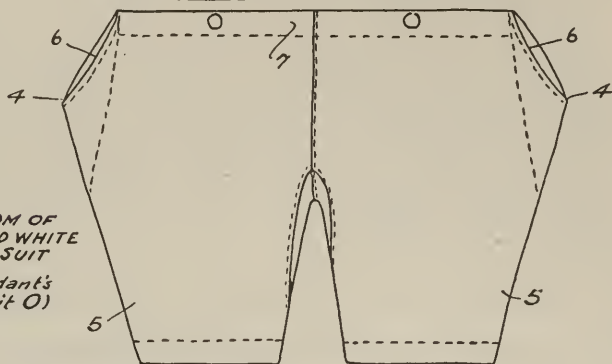
The learned judge in the lower court, in considering this phase of the case said:

"As a matter of fact, plaintiff's garment is none other than the Hollandese boy's costume

FRONT VIEW

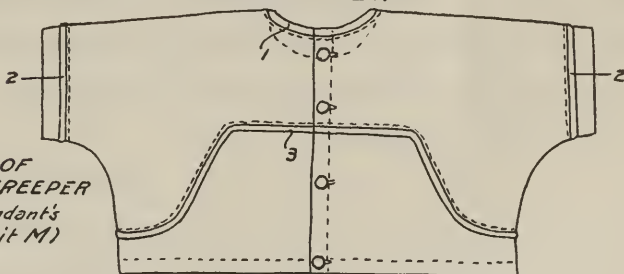


TOP OF
PINK CREEPER
(Defendant's
Exhibit M)

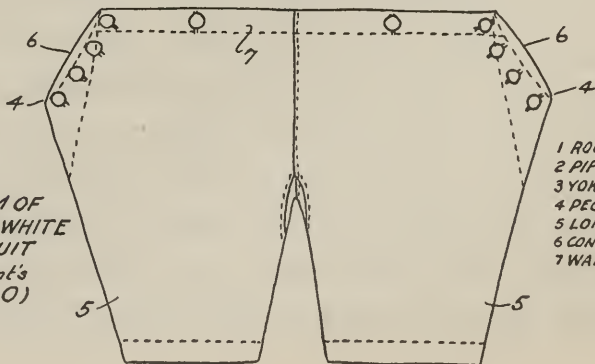


BOTTOM OF
BLUE AND WHITE
PLAYSUIT
(Defendant's
Exhibit O)

REAR VIEW



TOP OF
PINK CREEPER
(Defendant's
Exhibit M)



BOTTOM OF
BLUE AND WHITE
PLAYSUIT
(Defendant's
Exhibit O)

- 1 ROUND NECK
- 2 PIPING AT CUFFS
- 3 YOKE AND PIPING
- 4 PEG TOPS
- 5 LONG LEGS
- 6 CONCEALED POCKET
- 7 WAIST BAND

from time immemorial, known everywhere from use in original or modified forms, from paintings, engravings, illustrations and literature, to an extent warranting judicial notice" (Citing cases).

If, however, the last cited case relating to a design not thus known, be construed to forbid judicial notice as aforesaid, it is only necessary to advert to defendant's evidence thereof, viz. illustrations in Perkins' 'The Dutch Twins' published not later than 1915 by 'The Riverside Press' and various garments and designs of date not later, especially Averill's Design Patent No. 47447."

The Averill patent, referred to by Judge Bourquin is in evidence as Defendant's Exhibit J, and shows substantially everything contained in the patent sued on except the square Dutch neck. It shows in exaggerated form the peg shaped trousers, long legs, short sleeves, and patch pockets, as well as a belt with buttons.

Other exhibits, introduced by defendant which show that there is no invention in plaintiff's design are the two Zidell design patents, No. 52,720, issued Nov. 19, 1918, and No. 54,809, issued March 23, 1920, both prior to the filing of the application for the patent herein sued on. These two patents have already been considered by this court in *Zidell v. Dexter*, 262 Fed. 145, and *Faris v. Patsy Romper Co.*, 273 Fed. 900. They are in evidence in the present case as Defendant's Exhibits G and H. The

Zidell patents show a child's romper with a square Dutch neck, short sleeves, belt with buttons underneath the arm pits, peg top trousers, short legs and side pockets. Lengthen out the legs shown in the Zidell patents and we have the design of plaintiff's patent.

Defendant's Exhibit I, patent No. 1,255,491, issued to Verde on February 5, 1918, shows a square Dutch neck, short sleeves, a belt substantially the same as defendant's, and a flaring skirt. Add a pair of trousers to this patent and we have plaintiff's design.

The design patent issued to Simon E. Davis, No. 51,674, dated January 8, 1918, and introduced in evidence as Defendant's Exhibit F shows substantially the same design as Plaintiff's patent, with the exception of the peg top trousers. Add the peg shown in the Zidell patents and we have the plaintiff's design.

Is it not stretching one's credulity to assert that it would require invention, "something akin to genius", for the patentees, Miller and Macowsky to design plaintiff's garment when they had before them the Zidell design and the Davis design? The Davis design has every element of the plaintiff's patent with the exception of the pegs and these are supplied by Zidell. For convenience in making this comparison, we have reproduced Zidell Patent No.

52,720, and Davis Patent No. 51,674, on the opposite page, and underneath these appears the plaintiff's patent, No. 50,450, originally issued to Miller and Macowsky.

Not only did the patentees have before them the Davis and Zidell patents, but they are also presumed to have had before them the entire prior art, a portion of which consists of the Averill Patent, No. 47,477, the Verde Patent No. 1,255,491, the additional Zidell Patent No. 54,809, as well as the publication "The Dutch Twins", and the creations of the various manufacturers of children's creepers, rompers and play garments designed by the defendants, Kuh Brothers, as well as other concerns. Added to this we have the common examples of the United States Army trousers and the riding breeches of which the court will take judicial notice, both extensively used long before the application for plaintiff's patent. Indeed, a vivid imagination is necessary to inject invention into plaintiff's design.

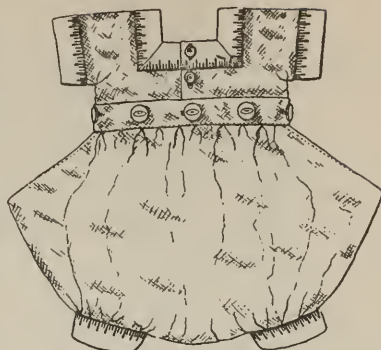
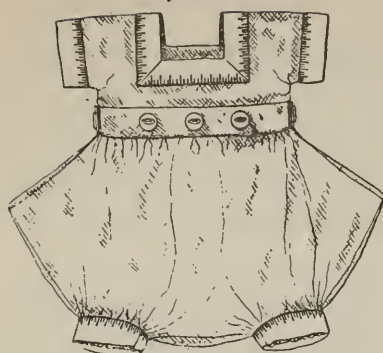
In *Smith v. Whitman Saddle Co.*, 148 U. S. 679, previously referred to as one of the leading cases on design patents and constantly affirmed and re-affirmed, the patentee took the front half of one prior art saddle and the back half of another prior art saddle and joined them together in a new saddle. The court held this to be no invention and says at page 680 of the report:

"In this case it appeared from the evidence that among other trees and saddles that were

W. I. ZIDELL.
CHILDREN'S ROMPERS.
APPLICATION FILED AUG 12, 1918.

52,720.

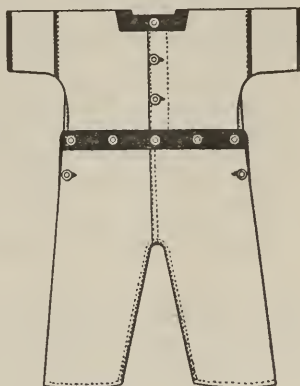
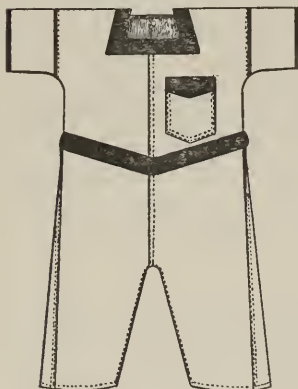
Patented Nov. 19, 1918.



S. E. DAVIS.
CHILDREN'S ONE PIECE OUTER GARMENT.
APPLICATION FILED OCT. 26, 1915.

51,674.

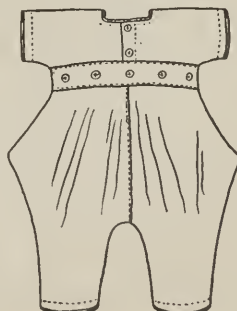
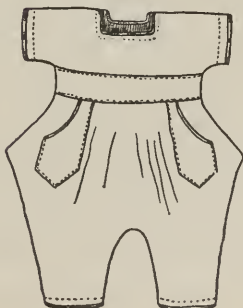
Patented Jan. 8, 1918.



J. MILLER AND D. MACOWSKY.
CHILD'S ROMPER.
APPLICATION FILED MAY 7, 1919.

56,450.

Patented Oct. 26, 1920.



old in the prior art was one called the Granger-tree, which had a cut-back pommel and a low, broad cantle, and was well known; and another called the Jenifer tree or Jenifer-McClellan saddle, which was also well known, and had a high, prominent pommel and a high-backed cantle, or hind protuberance, in the shape of a duck's tail. * * *

The saddle design described in the specification differs from the Granger saddle in the substitution of the Jenifer cantle for the low, broad cantle of the Granger tree. In other words, *the front half of the Granger and the rear half of the Jenifer, or Jenifer-McClellan, make up the saddle in question.* * * *

Nothing more was done in this instance (except as hereafter noted) than *to put the two halves of these saddles together* in the exercise of the ordinary skill of workmen of the trade, and in the way and manner ordinarily done." (Italics ours.)

We submit, therefore, that the case of *Smith v. Whitman Saddle Co.*, together with the evidence of the prior art referred to, is conclusive as to the absence of invention, or "anything akin to genius" in the plaintiff's patent. In the saddle case the patentee merely took the front half of one old saddle and the rear half of another old saddle and joined them together. In the case at bar the patentees merely took the top half of one old garment and the bottom half of another old garment and joined them together. If the faculty of invention was not displayed in the first instance, it was not displayed in the second.

II.

BUT EVEN IF PLAINTIFF'S PATENT IS VALID, THERE IS NO INFRINGEMENT.

Prior to, and at the time of the issuance of the patent in suit defendant had been manufacturing and selling a garment which closely resembled that shown in the patent. The garment is in evidence as Defendant's Exhibit P. Shortly after the issuance of the patent on October 26, 1920, defendant received notice from Miller & Macowsky, the patentees, to discontinue the manufacture of this garment. Later Mr. Macowsky visited defendant's place of business and after some discussion said:

"Let us get together on this, you stop manufacturing this garment, and sell what you have on your hands, and everything will be all right."

(Record page 117.)

In other words, a license was given defendant by one of the joint patentees, to sell all the garments it had on hand of the design shown in Exhibit P, alleged to infringe the Miller & Macowsky patent. (Record pages 105 and 117.)

Thereafter, and on March 8, 1921, a little more than four months after the issuance of the patent, Miller and Macowsky by an instrument in writing, assigned the patent to plaintiff. The testimony shows that the defendant still had on hand between 100 and 150 dozen garments covered by the license given by Mr. Macowsky, at the time the present plaintiff received an assignment of the patent.

(Record page 117.) Instead of disposing of this stock as it was, defendant "cut out the flare" or removed the "pegs" from the tops of the trousers, thus altering the garment to resemble that known as a "Koverall" in evidence as Defendant's Exhibit N. These garments, so altered were sold by defendant to a store in Sacramento. (Record pages 107 and 117.) This is not denied by plaintiff.

After disposing of the garments, so altered, to the dealer in Sacramento, defendant designed a new garment, introduced in evidence as Plaintiff's Exhibit 5 and the question therefore is whether or not Exhibit 5 is an infringement of the plaintiff's patent.

Patent to be construed in the light of the prior art.

Letters patent are always construed in the light of the prior art. It was said, in the case of *Griswold v. Harker*, 62 Fed. 389, that

"the question of infringement or non-infringement must be determined by the limitations placed upon the patent by the state of the art when it was issued."

and this has uniformly been held to be a correct statement of the law.

The questions of novelty and infringement are dependent upon the "state of the art" in design patents as well as in mechanical patents, and repeated references are found in the decisions on design patents, as to the prior art. The case of *Sutro Bros. v. Sloss*, 44 Fed. 356, is an example.

The plaintiffs' design-patented braid was a three ribbed design having something of the general appearance of a trefoil. The evidence showed that ribbed braid was old in the art. The defendant's four ribbed braid was declared not an infringement, for a broad construction could not be given the patent in view of the state of the art.

This doctrine is also illustrated in the case of *Untermeyer v. Jeannot*, 20 Fed. 503.

Another example of a design patent receiving a limited construction in view of the state of the art is the case of *Crocker v. Cutter*, 29 Fed. 456, where the court said:

"Easels made of natural cat-tails crossing each other near their upper ends are old. In view of this, the Crocker design must be limited to the mode of crossing the standards described in the patent. In defendant's design the standards are not crossed, but they are held together near the top by a band, from which point, by bending, they are spread out so as to present a fan-like appearance. If Crocker had been the first to design an easel made of cat-tails crossing each other, it might properly be held that the defendant's design infringed from the general resemblance between the two. In view however, of what was old, we have grave doubts whether the claim of the patent constitutes any invention; but, assuming the patentability of the design, we are clear that it must be limited to the mode of crossing the standards found in the specification and drawing, and, the defendant not using any form of crossing the standards, there can be no infringement, and the bill must be dismissed."

And finally the Supreme Court of the United States in *Smith v. Whitman Saddle Co.*, 148 U. S. 678, recognizes the limitations of the prior art as applied to design patents. The state of the art in that case showed that it was customary to vary the shape of saddles to suit purchasers and it was the lack of novelty, due to the state of the art, which was an important factor in reaching the conclusion that infringement did not exist.

The rule that the state of the art limits the scope of a design patent, has also been followed by this court in the case of *Zidell v. Dexter*, 262 Fed. 145, where the court points out the prior art and then says:

“It will thus be seen that there is nothing new in any of the features of the appellants’ design. He but brought together elements that there were old and well known. * * *

* * * And in cases where, as here, the elements of the design are all old, and the design is illustrated by drawings only, it has been held that in the absence of specifications the patentee who combines the old elements must be held substantially to the design which he exhibits by his drawing. In *Ashley v. Samuel C. Tatum*, 186 Fed. 339, 108 C. C. A. 539, it was held that in the absence of a specification calculated to secure to the patentee the predominant feature of his device, with or without ornamentation, the absence of ornamentation as shown in his drawing must be considered an essential element of the design, and it is not infringed by another design which shows such surface ornamentation. In *R. E. Dietz Co. v. Burr & Starkweather*, 243

Fed. 592, 156 C. C. A. 290, the court said that when a specification is filed with the drawing:

‘It must be construed together with the claim and drawing, as is the established rule in respect of other patents. The rules of interpretation are not different from those regulating other patents, and a design claim may (like any other) be restricted to the specific form shown.’

“And in *Ashley v. Weeks-Numan*, 220 Fed. 899, 136 C. C. A. 465, the court said:

‘The patentee having a patent with written specifications relating to an entirely new form of inkstand, he is entitled, not only to the exact design shown in his drawing of the patent, but also to the protection of the court against the making and marketing of inkstands, which contain the dominant features of the design described in the specification.’

“As already shown, we have no means of knowing which, in the mind of the inventor, was the predominant feature of his design. It seems obvious that one purchaser might be attracted by the shape of the collar, another by the ornamentation stitched on the collar, cuffs, and knee bands, another by the belt with large buttons, and another by the flaring effect of the trousers.”

Limiting Plaintiff's Patent by the Prior Art Defendant Does Not Infringe.

Applying the rule to the present case, that the state of the art limits a design patent, it is obvious that the plaintiff's patent must be very narrowly interpreted, if the court should find that it possesses any invention at all. If there is anything “akin to genius”, as required by the case of *Smith v. Whit-*

man Saddle Co., in plaintiff's design, it is apparent by the prior art that the "originality and beauty" displayed in the patent sued on must be limited to what is shown in the patent. The "effort of the brain as well as the hand", if it does rise to the dignity of invention in plaintiff's patent, is nevertheless restricted to such an extent, that it is readily apparent the defendant does not infringe. In the present case the differences in a design, which will avoid infringement, in view of the prior state of the art may be comparatively trivial, so long as the two designs can be reasonably distinguished.

Furthermore, as in the *Zidell* case, the elements of the design are all old, and where the design is illustrated by drawings only, it has been held that in the absence of specifications the patentee who combines the old elements must be held substantially to the design which he exhibits by his drawings. Holding the patentee "to the design which he exhibits by his drawings", it is clear that the defendant does not infringe.

Defendant's garment has a round neck, plaintiff's has a square neck; defendant's garment has a loosely detachable belt at the front, plaintiff's has an attached belt; defendant's garment has concealed pockets, plaintiff's has patch pockets; defendant's garment has a yoke and cuffs, plaintiff's has not; defendant's garment has piping at the yoke and cuffs, defendant's has not; defendant's garment has a fullness at the waist, plaintiff's has not; defend-

ant's garment has a high waist, plaintiff's has not; defendant's garment is primarily suited for girls, plaintiff's is not.

As an example of the slight modifications which avoid infringement, it is pointed out in the case of *Zidell v. Dexter*, 262 Fed. 147, such things as the omission of ornamental stitching, the omission of a belt with buttons, difference in the position of the flare of the trousers, the stitching of pockets and the addition of buttons, avoid infringement. This court has said:

"The garment known as No. 6 has all of the features of the patented design, excepting that the ornamental stitching is slightly different, and the collar, instead of being made square, is V-shaped. This the court held to be an infringement and the ruling in that respect is not challenged by appeal. Exhibit 4 differs from the patented design in that there is no ornamental stitching on the Dutch collar or cuffs, and no belt with buttons, and it is distinctly different in the shape of the trousers, which, instead of flaring midway, carry side pockets, flaring at the top of the trouser legs. Exhibit No. 5 has all the features of the design patent, except that it is not a single piece garment and has no ornamental stitching, and has two front pockets stitched upon the trouser legs. Exhibit 8 is similar to Exhibit 4, except that it has buttons upon the belt.

We do not think that the court below erred in holding that these garments do not infringe. In determining the question of infringement, both the character of the design and the nature of the fabric to which it is applied are to be taken into account."

In the case of *Soehner v. Favorite Stove & Range Co.*, 84 Fed. 189, involving a design patent, it is said:

“for while it must be admitted (and this is the contention most pressed by the complainant) that to the casual observer, or to one who regards their general appearance only, there is a sameness of appearance, yet it is only the sameness which results from the use by the defendant of the resources which were of right open to each,—that is, in this case, the privilege of using an old kind of ornament, in its common style of application, to the improvement of the appearance of his stoves.”

We submit therefore, that by reason of the limitation of the prior art and the differences in defendant's garment over the patented design, the defendant does not infringe.

File Wrapper and Contents of Plaintiff's Patent.

The patentees themselves, in the file wrapper and contents of the patent herein sued on, introduced in evidence as Defendant's Exhibit L, recognize what a slight variation their design was from the prior art, and what comparatively trivial differences avoided infringement.

The application for the patent herein sued on was at first rejected by the Patent Office for the reason • that

“There is held to be no invention herein over what is shown in design No. 52,720, Zidell, Nov. 19th, 1918. (Pants and drawers.) The claim is rejected and a patent is refused.”

The patentees however were not satisfied with this rejection and filed a lengthy argument with the request that the refusal of the Patent Office to allow the application be reconsidered. In this argument reference is made to the two Zidell design patents both in evidence in the present case, the first being No. 52,720 issued November 19, 1918, and the second No. 54,809, issued March 23, 1920, and it is said that

“The only apparent difference between the later patent to Zidell No. 54,809 and the earlier patent, is the removal of the blanket stitches and the omission of the buttons from the belt, and if these slight omissions constitute a patentable difference in the estimation of the Patent Office, then it is clear that the differences between the design of the present application and that of the Zidell patent of record easily amount to invention. * * * Apparently, the Patent Office proceeded on the theory that a design that did not infringe an earlier one was likewise not anticipated thereby”.

Reference is then made to the case of *Zidell v. Dexter*, 259 Fed. 582, that being the report of the case in the District Court, prior to its appeal to this court. The patentee's argument proceeds as follows:

“The Court in the case of *Zidell v. Dexter et al*, reported in 259 Fed. 582, held not only that the omission of the blanket stitches avoided infringement of the earlier Zidell patent, but also stated that the omission of any one of four other features would likewise so change

the character of the design as to avoid infringement, such other features being:

- (a) The Dutch or square neck;
- (b) Short kimona sleeves;
- (c) Flaring hips;
- (d) Waist band with large buttons."

That was, indeed, the holding of Judge Trippet, before whom the case was tried and shows what slight variations avoided infringement. But the point we now make is that the plaintiff's patentees, in order to obtain the patent herein sued on, acknowledged and adopted the ruling of Judge Trippet in *Zidell v. Dexter*, later affirmed by this court, and argued that *so slight a variation as the omission of blanket stitches on a garment avoided infringement*. But the patentees were then seeking to obtain a patent and were eager to acknowledge that only minor differences constituted invention or avoided infringement.

How differently the present assignee now argues! Having obtained the patent on such representations, they now seek to expand the invention so that it assumes a broad and generic character, forgetting that in order to secure the patent, the original applicants distinguished it from the reference *Zidell* by saying:

"it is to be noted that the blanket stitches have been omitted from the cuffs and neck bands; that patch pockets have been added to the flaring hips, and that the legs of the trousers have been considerably lengthened."

Only three things distinguished their patent from the Zidell patent No. 52,720 viz.: (1) the omission of the blanket stitches, (2) the addition of patch pockets, and (3) lengthening the trousers, all elements well known in the prior art.

It is the old story of limiting and narrowing the invention in the Patent Office in order to secure a patent, and afterwards coming into court and repudiating that position and claiming a broad and generic invention. It was the variations and modifications of the prior art that secured the patent and these same variations and modifications must now constitute a limitation of its scope. Plaintiff has not secured a patent on a "peg-top" garment as its argument would lead us to believe. If that were the case, every officer of the United States Army, every gentleman rider in a country club, and every clown in a circus would come dangerously near infringement. No such scope can possibly be attributed to plaintiff's design. It consists only in bringing together old elements with possibly slight modifications in form, and the invention, if any exists, must be limited to such modifications.

Defendant's Garment Distinguished from Plaintiff's Patent.

Defendant's garment as shown in Exhibit 5 is easily distinguished from plaintiff's patent. One of the witnesses, Miss Henrietta Loeb, makes this comparison between a "Jim Dandy" garment manufactured by defendant and a "Kute Kut" garment made by plaintiff in accordance with its patented

design. The testimony commences at page 120 of the record:

“Q. Now, as a person acquainted with things of this kind, will you please point out for me the difference between these two that would attract your eye?

A. I consider these two garments entirely different, one is a strictly girl's garment, and the other one a boy's.

Q. Point out the differences between the Kute Kut and the Jim Dandy.

A. It has a fullness here.

Q. Which one do you mean?

A. This one here, the Jim Dandy.

Q. What kind of a shaped neck do you find?

A. This is a round neck.

Q. The other one, of course, is a square neck?

A. Yes, what they call a square Dutch neck.

Q. That is called a square Dutch neck?

A. Yes, just a matter of difference of opinion.

Q. What do you find with respect to the pockets of the two, as to difference?

A. This is entirely different, this is the continuation of the yoke.

Q. You mean the Jim Dandy?

A. The Jim Dandy is the continuation, and the pockets are concealed in the fullness at the sides.

Q. Where are the pockets in the other?

A. They are on the outside.

Q. Would these differences make any impression on you, or attract you?

A. Decidedly. It is a better garment for a girl.

Q. The Jim Dandy?

DESIGN.

J. MILLER AND D. MACOWSKY,
CHILD'S ROMPER.
APPLICATION FILED MAY 7, 1919

56,450.

Patented Oct. 26, 1920.

PLAINTIFF'S GARMENT

Fig. 1.

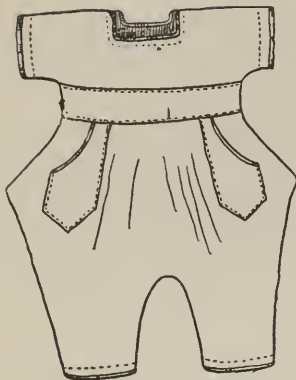
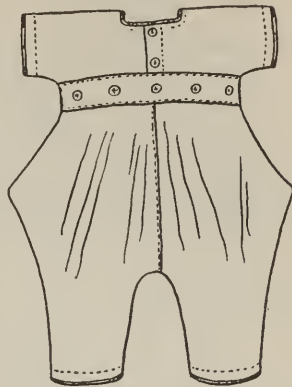


Fig. 2.



DEFENDANT'S GARMENT

Fig. 1.

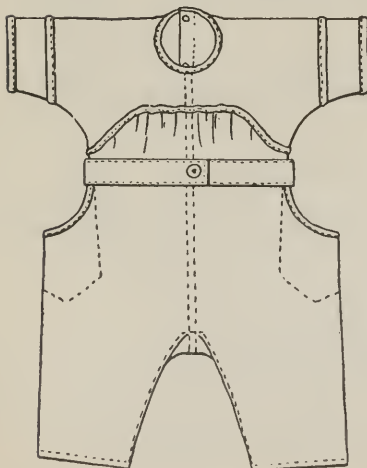
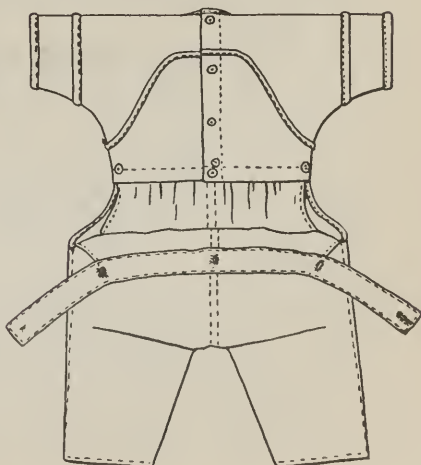


Fig. 2.



A. Yes, this garment here is a better garment for a girl, and the reason why I think it is different is because it is patented, and I do not see how the United States Patent Office could issue any patent on anything that was not different. * * *

Q. Now, in regard to this Exhibit 3, do you find the waist band here extending up underneath the arm-pits?

A. No. This I would consider a little bit lower, and the yoke effect is the continuation of the front; it has the same effect in the back as in the front in regard to the yoke.

Q. Does the yoke have any effect on the appearance?

A. Yes, absolutely it does.

Q. How about the cuffs?

A. The cuffs, as well, and has a loose belt.

Q. The belt has a decided effect?

A. Exactly."

To the same effect is the testimony of Miss L. V. Richards, commencing at page 97 of the Record:

"Q. Will you please point out the differences that you detect between these two garments, from examining them with ordinary care?

A. A sewed-in belt.

Q. That is, the Kute Kut has a sewed-in belt, you say?

A. Yes.

Q. What else?

A. Pockets, square neck, short sleeves, peg top.

Q. Now, the other one has what?

A. This one has a yoke.

Q. Which is the yoke there?

A. This part, here, and then it has a fullness through here that they like for girls.

Q. What do you mean by "fullness"?

A. A fullness from the yoke down, which makes a difference effect garment than the other one.

Q. This red border that you have here is the yoke?

A. This is the piping.

The COURT. Q. Is that the yoke at the back?

A. That is the yoke sewed on.

Q. There is a yoke on the back sewed on?

A. Yes. You see, there is a fullness in here that the other hasn't. That gives the fullness for a girl that is not given for a boy; that a boy does not need.

MR. MILLER. Q. What is the shape of the neck here?

A. Round; the other is square; this has a cuff, the other one has not a cuff; one has a patch pocket, and the other has not.

Q. I show you another one of these Jim Dandy garments, which I have ripped apart.

A. I know at a glance that it has a yoke.

Q. This one that I have ripped apart shows the yoke, does it?

A. Yes, the other one has not a yoke; the other is simply a bodice sewed on to the trousers.

Q. This fullness that you speak of is shown in front?

A. Oh, yes, they like that especially for girls; it is especially adapted for girls * * *

Q. As a matter of fact, has anyone, to your knowledge, ever been deceived in buying one of these garments in your store?

A. No; that is the reason why we keep all of them, so as to please the customers.

Q. You would just as leave sell one as the other?

A. Equally so."

The testimony of Simon E. Davis, commencing at page 88 likewise includes a comparison of the plaintiff's and defendant's garments.

"A. The Kute Kut has a square neck, and the Jim Dandy has a round neck; the Kute Kut has no cuff, or binding, or piping in the sleeve, other than at the end, and the Jim Dandy has. The Kute Kut has no yoke or no binding where the yoke is, and the Jim Dandy has. I am just taking the front now. The Kute Kut has outside patch pockets and the Jim Dandy has inserted pockets. The Kute Kut has the simulation of a belt and the Jim Dandy has the belt. That is the only difference I can see in the front of the garment.

Q. Now take the back.

A. On the back the same remarks apply to the sleeves, the same remarks apply to the yoke, and that is all."

The defendant's garment, formerly known as the "Jim Dandy", and so referred to by the witnesses was later renamed the "Jane Dandy". (Record page 105.)

All testimony in reference to the opinion of the witnesses as to whether or not purchasers would be deceived in taking the "Jim Dandy" garment for the "Kute Kut" was excluded by the trial court. This is apparent from the following quotation from the record, at page 89, when Mr. Simon E. Davis was testifying:

"Q. Now, in view of these differences, and of the similarities that there are between the two garments, in your opinion would a person desir-

ing to purchase one of the Kute Kut garments and using ordinary caution and care that purchasers of these garments use, be deceived into taking the Jim Dandy garment for the Kute Kut, if the Jim Dandy were offered him in place of the Kute Kut?

MR. ACKER. The question is objected to as merely calling for an expression of opinion of this witness, the same objection that Mr. Miller made as to the plaintiff's witnesses.

MR. MILLER. I am entitled to show it if he was entitled to.

THE COURT. We have excluded testimony in reference to opinion, and we will do the same now."

No expert testimony therefore appears in the present case, and the question of whether or not a purchaser, using ordinary care, would be deceived in taking defendant's garment for the plaintiff's, was left for the court to decide.

Variations in Garments Noticed by Women.

The differences in designs, which under the patent law will avoid infringement, are differences which will attract the attention of the ordinary observer giving such attention as a purchaser usually gives in buying articles of the kind in question and for the purposes for which they are intended. This is the general rule applicable to design patents as set forth in the case of *Zidell v. Dexter*. In the present case by reason of the state of the art, the general rule should have a very narrow application. The record discloses that there were many types of

children's garments on the market, long before plaintiff's design. Playsuits, rompers, creepers and other outer garments for children were old. Similar garments with but slight variations, must have been well known to women who were the "ordinary purchasers", buying articles of this kind. Mr. Simon E. Davis, at page 91 of the record, testified as follows:

"Q. Who are the people who generally purchase these garments at retail?

A. Mothers or women."

Likewise Miss Richards, at page 96 of the record, testified as follows:

"Q. Who generally comes in to purchase these, what class of people?

A. Mothers.

Q. What degree of care do they use in selecting the different garments that they want?

A. They usually come and tell us what they want.

Q. How do they ask for these things?

A. They come and ask for Kute Kut, Jim Dandy, or Koveralls.

Q. Has anybody ever come in and asked you for Kute Kuts and you handed them out Jim Dandies?

A. No, we carry both.

Q. And you sell them by the names, do you?

A. Yes."

Miss Richards was employed by O'Connor-Moffatt & Co. and had charge of the children's department of that store.

The testimony, therefore, shows that women were the "ordinary purchasers" of the garments in question. Indeed, this could be assumed from the very nature of the article. To women, therefore, and especially to mothers, the various forms and modifications of children's garments were well known. They knew what they wanted. They even called the garments by name. Certainly to mothers who were making purchases for their children, the differences between defendant's and plaintiff's garments must have been readily apparent. If these differences of design attracted their attention, then under the rule of patent law previously announced the defendant's garment cannot be held to infringe the plaintiff's patent.

The same situation arose in the case of *Zidell v. Dexter*, 262 Fed. 147, where a child's garment was also involved and this court said:

"The evidence shows that at and prior to the conception of this design there were in use and on sale very many similar garments, with variations in design so slight as to leave to the ordinary observer the impression of a very general resemblance, and we must assume that to womankind, who are the purchasers in the main of this class of garment, these various coincident forms of garments were known, and whether such purchasers would be deceived into taking the garments which are alleged to infringe for a garment of the patented design would necessarily depend largely upon that general knowledge. There is no evidence that any purchaser has in fact been so misled."

We assert, therefore, that the differences in design are readily apparent to women purchasers.

Defendant Uses Old Elements With Its Own Variations.

Where a design invention consists only in bringing together old elements with slight modifications in form, the invention is confined to those modifications, and a person using *the same elements with his own variations of form does not infringe*, if his design is reasonably distinguishable from the patented design. That was the rule announced by this court in the case of *Zidell v. Dexter*, 262 Fed. 145, where, as in this case, a design patent for a child's garment was involved. The patent sued on in the *Zidell* case was Design Patent No. 52,720 issued November 19, 1918, and introduced in evidence in the present case as Defendant's Exhibit G. This court speaking through Judge Gilbert, said:

"The patent was obtained without specifications or description other than drawings of the design, and it gives to the public no notice that any particular element or group of elements of the design is predominant. On the face of the design the more prominent distinguishing features would appear to be (1) a square Dutch collar; (2) the ornamentation of collar, wrist bands and knee bands; (3) a belt with large buttons; and (4) the flaring or peg shape of the trousers. The prior art is shown by the Verdi patent, No. 1 255,491, issued October 15, 1917, for a 'child's garment', in which is shown a square neck, short sleeves, flaring or peg-shaped skirts, and a belt, all in general resemblance to the appellant's design. Patent No. 47,447, is-

sued to Georgene Averill, June 15, 1915, presents a combination of short sleeves, belt, and peg-shaped trousers. Patent 51,674, issued to S. E. Davis, January 8, 1918, for 'child's one-piece outer garment', exhibits the general features of the appellant's design, with the single exception that the trousers are long and have not the peg shape. An advertisement in a Los Angeles daily paper of May 25, 1917, displays a picture of a one-piece child's garment called 'Peggy Jeans', showing a square neck, short sleeves, sleeve cuffs, and belt, and an advertisement in a Los Angeles paper of June 5, 1917, shows a garment called 'Klever Kiddie', with Dutch neck, short sleeves, with cuffs, and flaring trousers, with general peg effect. Other advertisements of the year 1917, display similar one-piece rompers with the Dutch neck, short sleeves, sleeve cuffs, belts, and short trousers, the latter full, but not peg-shaped."

"It will thus be seen that there is nothing new in any of the features of the appellant's design. He but brought together elements that were old and well known. Single piece child's rompers with belts were old. Square Dutch collars were old. Ornamental stitching was old. Peg-shaped trousers were old."

The Verdi patent No. 1,255,491, issued October 15, 1917, the Averill patent No. 47,447, issued June 15, 1915, and the Davis patent No. 51,674, issued January 8, 1918, are all in evidence in the present case. In addition to these patents the book entitled "The Dutch Twins" and the defendants prior art garments, known as the pink romper and the blue and white playsuit, previously referred to, are also

in evidence, which makes the present case even stronger than the *Zidell* case. If in the former case it can be said of the patentee, that:

“He but brought together elements that were old and well known.”

Certainly it is also true of the instant case.

The court then proceeds at page 146 of the report as follows:

“In a design invention, which consists only of bringing together old elements with slight modifications of form, the invention consists only in those modifications, and *another who uses the same elements with his own variations of form does not infringe, if his design is distinguishable by the ordinary observer from the patented design.* This is the conclusion deducible from the leading case of *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 13 Sup. Ct. 768, 37 L. Ed. 606. (Italics ours.)

There can be no doubt that every element in plaintiff's design is old. This is admitted by Mr. Herbert Eloesser, vice-president of the plaintiff corporation, at page 51 of the record where he says:

“Every element of that is old; it is merely the arrangement of them that I consider novel.”

In the present case, as in the *Zidell* case, the patentee has only brought together old elements, with perhaps slight modifications in form. The defendant also uses the same old elements with its own modifications of form. Both plaintiff and defendant

having done this, under the authority of the *Zidell* case, if the designs are distinguishable by the ordinary observer, there is no infringement.

III.

PLAINTIFF'S BRIEF WHOLLY MISCONCEIVES DEFENDANT'S CONTENTIONS.

While certain prior patents and publications are set up in defendant's answer, as anticipating plaintiff's patent, it was not contended that any one of these singly and alone anticipated plaintiff's design. But all of these prior patents and publications together, with such additional showing of the prior art introduced in the record of this case, prove, we believe, beyond a reasonable doubt that the plaintiff's design *does not disclose invention*. Plaintiff's counsel takes up each of the prior patents and publications separately and argues at great length that this patent or that drawing does not constitute an *anticipation* for the reason that it can be distinguished from the patent in suit. Nowhere does he contend, however, that the design in question constitutes *an invention over the prior art*. In other words, considering all these prior patents, prior publications and prior garments together as constituting the state of the art at the time the plaintiff's application was filed, plaintiff's counsel does not contend that the patent in suit amounts to an invention within the meaning of the statute and as

interpreted by the courts. This is the issue raised by the defendant and this is the issue which must be met.

But in passing, it must be noted that on the question of anticipation the brief particularly refers to the prior publication entitled "The Dutch Twins", in evidence as Defendant's Exhibit "E". The principal reason urged by plaintiff, as to why this publication is not an anticipation seems to be that it discloses a three-piece garment whereas it is alleged that plaintiff's patent portrays a one-piece garment. It is obvious, however, that such a difference is not a difference in design covering the ornamentation or beauty of the garment. It is merely a "mechanical" difference. The designs may be identical although one is embodied in three separate pieces, whereas in the other, the three pieces are sewed together in a single garment. But further than this, if, as counsel states, the publication called "The Dutch Twins" does not disclose a "one-piece" garment, it can with equal force be asserted that the design embodied in the drawing of the plaintiff's patent, likewise *does not disclose a "one-piece" garment*. It may be in several pieces. The fact that the plaintiff manufactures the garment in one piece is beside the point. It is the design as shown and claimed in the patent that is material and neither in the drawing nor in the specification is there any reference limiting the design to a *one-piece garment*.

If, therefore, the “mechanical” difference, or in other words, the variation of construction is immaterial, it is obvious that the publication is almost the precise equivalent of the plaintiff’s design. In the words of the lower court:

“As a matter of fact plaintiff’s garment is none other than the Hollandese boy’s costume from time immemorial known everywhere from use in original or modified forms, from paintings, engravings, illustrations, and literature, to an extent warranting judicial notice * * * it is only necessary to advert to defendant’s evidence thereof, viz., illustrations in Perkins’ ‘The Dutch Twins’, published not later than 1915 by ‘The Riverside Press’ * * * between plaintiff’s design and garment and those of the illustrations of ‘The Dutch Twins’, there is no substantial difference.

In appearance and impression they are alike, are one design, of which either patented, the other would anticipate or infringe. It follows therefore that by reason of this anticipation, publication and lack of invention, plaintiff’s patent is invalid.”

In plaintiff’s brief, some stress seems to be laid on what is termed the “Attitude of Defendant” and the fact that the defendant did not keep “full faith” with the patentees. As previously stated, the defendant, prior to and at the time the patent herein sued on was issued, had been making a garment closely resembling the patented design. This is in evidence as Defendant’s Exhibit P. After receiving notice that Miller and Macowsky had received a patent on the design, defendant discontinued manu-

facturing garments of the type shown in Exhibit P and obtained a license to sell the stock it had on hand. When the patent was assigned by Miller and Macowsky to plaintiff, approximately 100 dozen of these garments remained unsold. They were then altered so as to eliminate the side extensions or "pegs" and sold to a dealer in Sacramento. (Record pages 107-108.) The garment made and sold by defendant (Exhibit P) had been designed without knowledge of the patent in suit, and the first time that defendant heard that the garment it was selling had been patented was when a letter was received from Miller and Macowsky giving notice of the issuance of the patent herein sued on. (Record pages 103-104.) So much seems to be undisputed.

After receiving notice of the issuance of a patent, and while operating under a license, the defendant decided it would manufacture an entirely different garment. Mr. Louis Kuh testified as follows on page 105 of the record:

"A. The fact of the matter is that when we first heard that Macowsky claimed that he had a patent on this garment, we had decided that we would get out another garment. * * *"

A new garment was then designed in which two other garments, previously made by defendant were combined. This new garment is in evidence as Plaintiff's Exhibit 5 and is the subject matter of the present suit.

Where is there a lack of good faith on the part of defendant? It discontinued the sale of its former

garment and commenced manufacturing one that it believed would not infringe plaintiff's patent. Surely the fact that it continued to manufacture children's rompers or playsuits is no evidence of lack of good faith. On the contrary, the fact that it discontinued making a garment substantially similar to plaintiff's patent and altered its design, shows that defendant preferred to respect plaintiff's patent and wanted to avoid infringement by designing a new garment. And so the prior art was resorted to as the defendant undoubtedly had a right to do. Children's playsuits were old. Peg top trousers and the other elements used by defendant were old. These old elements were embodied in a new combination and created a design which defendant believed could be readily distinguished from plaintiff's patent. And so defendant continued manufacturing and selling children's garments as it had been doing for many years prior to the issuance of plaintiff's patent.

Plaintiff's brief also refers to "Public Acquiescence and Recognition" of the design embodied in the patent in suit. But the courts are rarely willing to accept evidence of commercial popularity as evidence of invention and will never do so unless the question of invention is one of grave doubt. On this point the Supreme Court, in *McCain v. Ortmyer*, 141 U. S. 419, says:

"That the extent to which a patented device has gone into use is an unsafe criterion, even of its actual utility, is evident from the fact that the general introduction of manufactured articles is as often affected by extensive and judi-

cious advertising, activity in putting the goods upon the market and large commissions to dealers, as by the intrinsic merit of the articles themselves. * * * If the generality of sales were made the test of patentability, it would result that a person, by securing a patent upon some trifling variation from previously known methods, might, by energy in pushing sales, or by superiority in finishing or decorating his goods, drive competitors out of the market, and secure a practical monopoly without in fact having made the slightest contribution of value to the useful arts. * * * While this court has held in a number of cases * * * that in a doubtful case the fact that a patented article had gone into general use is evidence of its utility, it is not conclusive even of that—much less of its patentable novelty.”

The court affirmed this ruling in *Adams v. Bellair Stamping Co.*, 141 U. S. 539, and *Duer v. Corbin Cabinet Lock Co.*, 149 U. S. 216, and others. The District Courts and Circuit Courts of Appeals throughout the United States have made similar rulings in many reported cases, some of which have been in this Circuit, *Klein v. City of Seattle*, 77 F. R. 200; *American Sales Book Co, et al. v. Bullivant*, 117 F. R. 255, and *Hyde v. Minerals Separation, Limited, et al.*, 214 F. R. 100, being notable examples.

Defendant did not, as asserted by plaintiff's counsel “wilfully appropriate plaintiff's design inventions.” Defendant made a garment similar to plaintiff's patent long before it had knowledge of the issuance of the patent, and when defendant

found that the garment it was manufacturing had been patented by another, it promptly stopped making this garment and secured a license to dispose of the stock on hand, and then designed an entirely new garment. The yoke was added. The pockets were concealed. The loose belt was used. A fullness about the waist was substituted. Piping was inserted at the cuffs and yoke and the garment was generally altered so as to make it suitable for girls. In addition to this the name was changed from "Jim Dandy" to "Jane Dandy", so as to disassociate it from the former garment and make it characteristically feminine. Instead of the defendant appropriating plaintiff's design, it has done all in its power to avoid plaintiff's design and create a design of its own. It still however manufactures children's rompers and playsuits as it always has done, but under its own trade name and under its own design of garment.

We submit:

(1) That the plaintiff's patent discloses a design which originated through the trade instinct of the manufacturer and seller, and does not embody the genius of invention, therefore rendering the patent invalid for want of invention.

(2) That if the patent is valid, it consists only in bringing together old elements with slight modifications in form and the defendant using the same elements with its own variations does not infringe

for the reason that its design is reasonably distinguishable from the patented design.

Dated, San Francisco,
March 5, 1924.

Respectfully submitted,

JOHN H. MILLER,

A. W. BOYKEN,

Attorneys for Appellee.